

Patents

Serial No.: 10/713,855

Response Dated January 6, 2006

Response to Office Action of September 7, 2005

REMARKS

Claims 1-5 are pending in this application. Claims 1-5 are rejected under 35 USC § 103(a) as being unpatentable over Borghi (6,056,775) in view of Clerc (6,860,900).

Examiner has failed to make a *prima facie* case for obviousness. MPEP 706.02(j) provides in relevant part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The prior art lacks the relevant motivation to combine teachings to reach the present invention. As a matter of law, absent motivation to combine the disparate teachings contained in the art, an obviousness rejection is improper. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). Reliance on skill in the art absent motivation to combine references is also improper in reaching a conclusion of obviousness. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The present invention is for a stent graft device having a rail providing longitudinal support and stent and stent graft elements which are movable along the rail. Further the stent and stent graft sections themselves are movable with respect to each other along the rail.

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Borghi discloses a stent device having a fixed backbone on which the terminal ends are fixed such that the different portions of the stent are not movable with respect to each other.

In the preferred embodiment the connectors 9 may be constructed to be mounted on the In some instances, it may be desirable to modify the stent so that one or more of the modules (**but not the endmost modules**) are not securely attached to the support wire but, instead, are permitted some freedom of sliding movement along the support wire. This may enable making of a final adjustment to the position of the module after the device has been placed in the patient's blood vessel, should that be desired. Emphasis supplied, column 5, lines 56-64

The present invention has no such limitation on fixing the terminal ends. In addition, Borghi is a stent intended solely for holding the walls of the vessel in an expanded state and not a graft intended to protect the vessel walls from internal pressure. Borghi does not teach a graft element or teach that the device is useful as a graft. Clerc does not solve the shortcomings of Borghi. While Clerc discloses a stent graft, it fails to disclose a graft with stent and graft elements that slide relative to each other or the need therefore. Combined it is unclear how Borghi and Clerc teach a device in which all elements are capable of movement along a rail.

The Examiner has stated that prevention of restenosis is the incentive for combining the two references. Neither Borghi nor Clerc suggest that restenosis is a problem with their respective devices. Nor is any reference cited which suggest a need to prevent restenosis which is solved by the combination of Borghi and Clerc. Further there is no suggestion in either Borghi or Clerc that their respective devices alone or in combination with other references will prevent restenosis. In fact, the problem at hand in the present invention is not restenosis but preventing an aneurism from rupturing.

The Examiner is encouraged to call the undersigned attorney if doing so will facilitate prosecution of the application.

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Respectfully submitted,

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Attachments: Extension of Time
Fee Transmittal